

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEIL E. MORROW and ROBERT J. MORROW

Appeal No. 2004-0136
Application No. 09/761,340

ON BRIEF

MAILED

FEB 19 2004¹

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 57-61, 65, 68, 69, 72 and 97-102. Claims 62-64, 66, 67, 70, 71 and 73-83 have been withdrawn from consideration as being drawn to a non-elected species, and the remaining claims have been canceled.

We AFFIRM-IN-PART AND ENTER A NEW REJECTION UNDER
37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a boot. An understanding of the invention can be derived from a reading of exemplary claim 57, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Spademan	4,360,979	Nov. 30, 1982
Ottieri	4,969,278	Nov. 13, 1990
Battistella <u>et al.</u> (Battistella)	5,060,403	Oct. 29, 1991

Claims 68 and 99-102 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

The following rejections stand under 35 U.S.C. § 102(b):

- (1) Claims 57, 58, 60, 61, 65, 68, 69, 72, 97, 98 and 102 on the basis of Battistella.
- (2) Claims 57, 58, 59, 65, 68 and 69 on the basis of Spademan.
- (3) Claims 99-101 on the basis of Ottieri.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 20) for the examiner's complete reasoning in support of the rejections, and

to the Brief (Paper No. 19) and Reply Brief (Paper No. 21) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under The Second Paragraph Of Section 112

This rejection is directed to claims 68 and 99-102, although we observe that the examiner has not taken exception with any of the language in claim 102 and therefore it appears inadvertently to have been included in this rejection (Answer, page 3).

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. Evaluating the examiner's positions regarding this rejection leads us to conclude that it should not be sustained.

The examiner first finds the term "unrestrained" as used in claims 99, 100 and 101 to be "unclear, inaccurate and indefinite" since the cable portion "is under tension and therefore is not unrestrained at any portion" (Answer, page 3). The cable portion that is "unrestrained" in claim 99 is between the second guide (140) and the third guide (132), and in claims 100 and 101 the cable is "unrestrained" between the first guide (134) and the second guide (140) and between the second guide (140) and the third guide 132). We agree with the appellants that it would be clear to one of ordinary skill in the art from the explanation of the invention in the specification that "unrestrained" means that the specified portions of the cables are not attached at points between the pairs of guides and are free to slide with respect to the guides when they initially are adjusted (see, for example, pages 13 and 14, and Figures 1 and 3). Thus, we find this term not to be indefinite.

We reach the same conclusion with regard to the examiner's position that in claim 68 it is "not clear what 'first and second locations' of the front portion are 'substantially adjacent each other'" (Answer, page 3). Claim 65 recites a "front portion," and claim 68, which depends therefrom, adds the further requirement that this "front portion" comprise first and second locations that are substantially adjacent to one another. As shown in Figure 36, the cables attach to the front of the boot at one portion (236 as indicated by the solid lead line and arrow), but at two locations (236 as

indicated by the broken lead line and 238). From our perspective, this would have been evident to the artisan and does not cause the claim to be indefinite.

The Section 112 rejection is not sustained.

The Rejections Under Section 102(b)

The guidance provided by our reviewing court with regard to the matter of anticipation is as follows: Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, that is, all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

At the outset, we point out that the appellants argue with regard to both of the Section 102 rejections that the references do not disclose or teach boots having a

"forward-lean system," and therefore cannot anticipate the subject matter recited in the claims, all of which recite that limitation. The appellants assert on page 2 of the Brief that "forward-lean system" is

a term of art recognized by persons skilled in the art and is applied to a device arranged to provide a controlled amount of forward-lean in a boot, i.e., meaning the portion of the boot around the lower leg is controlled either to increase or reduce the angle of leaning.

The appellants have not directed us to such a definition in the specification, nor have they provided evidence from other sources that this is the definition that one of ordinary skill in the art would attach to the phrase "forward lean system." Furthermore, we note on page 4 of the specification the statement that an object of the appellants' invention is "to provide an improved snowboard boot with adjustable forward lean" (emphasis added), which would imply that boots are known in the art which provide non-adjustable forward lean to the lower portion of the leg. Further in this regard, on record in the application file (with Paper No. 16) is a declaration of Anthony Derocco, dated January 7, 2003, in which the declarant states that the three references cited against the claims do not have forward lean systems. However, the declaration does not explain why the claimed boot is a "forward lean" boot while the three references are not, and therefore we find it not to be entitled to sufficient weight to refute the examiner's position, which is that the references disclose "forward lean" systems because the boots impart forward lean to the wearer's lower leg.

We agree with the examiner that all three of the references disclose "forward lean" systems, that is, systems in which the wearer's leg is positioned by the boot to lean forward, noting that such clearly is shown in Figures 1, 6 and 7 of Battistella, Figure 2 and 4 of Spademan, and Figures 1, 4, 6, 10A and 13 of Ottieri.

(1)

The first of the Section 102 rejections is that claims 57, 58, 60, 61, 65, 68, 69, 72, 97, 98 and 102 are anticipated by Battistella. Claim 57 recites, inter alia, medial and lateral side cable members attached to the forward portion of the boot at only one general position. We agree with the appellants that such an arrangement is not disclosed or taught by Battistella. In the embodiments shown in Figures 1-5, 7, 8 and 9, there appears to be a cord only on one side of the boot. In the embodiment of Figure 6, there are cords on both sides of the boot, but they are not attached to "the forward portion of the boot," nor are they attached at only one location. Battistella therefore does not anticipate the subject matter of claim 57 or, it follows, of claims 58, 60 and 61, which depend from claim 57. Independent claims 65 and 97 also contain these limitations, and therefore this rejection of claims 65, 68, 69, 72, 97 and 98 also cannot be sustained.

Claim 102 recites a boot comprising "cables from either side of the upper, rear ankle portion attached to the lower front foot portion . . . for applying a forward-leaning force to the boot upper ankle portion from only a single general position" (emphasis

added). We interpret this claim to be so broad as not to require that cables be located on both sides of the rear ankle portion, but merely on either the medial or the lateral side of the boot. Such is the case in the boots disclosed by Battistella, and therefore we shall sustain this rejection of claim 102.

(2)

The second rejection under Section 102 is that Claims 57-59, 65, 68 and 69 are anticipated by Spademan. We find ourselves in agreement with the positions taken by the examiner in this rejection, and we will sustain it.

Looking first to claim 57, Spademan discloses a forward lean boot comprising, to the same extent as the appellants' invention, a medial cable member extending from anchor point 16 to a common attachment means 10 and a lateral cable member extending from anchor point 20 to common attachment means 10. We regard attachment means 10 as being attached "to the forward portion of the boot," as is required by the claim, inasmuch as it is located forward of the rear of the boot. In this regard, the appellants have not pointed out why the Spademan location should not be considered to meet this limitation of the claim, and we note the similar location of the attachment means in the illustration of the appellants' invention in Figure 3 of the drawings. An adjustable tension member 11 comprising guiding grooves 12 and 13 is connected to the Spademan cable members "for altering the length of the cable members," to the same extent as the appellants' invention does so. Further in this

regard, it appears to us that in the appellants' invention it is not the length of the cables that is altered, but the tension, as is clear from the explanation provided on pages 13 and 14 of the specification and the showing in Figures 13-16. This matter is the subject of a new rejection under 37 CFR § 1.196(b), which is set forth below.

This rejection of independent claim 57 is sustained. Since the appellants have chosen not to present arguments regarding the separate patentability of dependent claims 58 and 59, which depend from claim 57, and independent claim 65 and dependent claims 68 and 69, they fall with claim 57. See In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

(3)

Claims 99-101 stand rejected as being anticipated by Ottieri. All three of these claims require, inter alia, that the second one of the three guides for the cables be located on a front portion of the boot at a location lower than the first guide. The reference does not state that the second guide (in portion 62) is lower than the other two guides (80), and we do not share the examiner's opinion that this is clear from Figure 1. We therefore will not sustain this rejection.

New Rejection By This Panel of The Board

Pursuant to our authority under 37 CFR §1.196(b), we enter the following new rejection:

Claims 57-61 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claim 57 recites "a tension adjustment member connected to the cable members for altering the length of said cable members, to provide more or less forward-lean of the boot relative to a vertical line." As explained on pages 13 and 14 of the appellants' specification and illustrated in Figures 13-16, tension cable 126 passes through one of a number of apertures in an engagement member 122. Moving member 122 from the position shown in Figure 16 to that shown in Figure 3 places tension upon cable 126, which results in forward lean applied to the rear portion of the boot. Although the phrase "for altering the length of the cable" appears in claim 57 as originally filed, there is no explanation in the specification regarding such a feature and no description of a length altering mechanism, and it does not appear from the drawings that such actually occurs. While it is the operation of the tension adjustment member acting upon the cable which results in the application of forward lean in the invention as disclosed, such does not occur because the length of the cable is altered. The invention therefore is

inaccurately described in claim 57, which causes this independent claim, and dependent claims 58-61, to be indefinite.

CONCLUSION

The rejection of claims 68 and 99-102 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 57, 58, 60, 61, 65, 68, 69, 72, 97 and 98 as being anticipated by Battistella is not sustained.

The rejection of claim 102 as being anticipated by Battistella is sustained.

The rejection of claims 57, 58, 59, 65, 68 and 69 as being anticipated by Spademan is sustained.

The rejection of claims 99-101 as being anticipated by Ottieri is not sustained.

Pursuant to 37 CFR §1.196(b), claims 57-61 are newly rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR §1.196(b)



IRWIN CHARLES COHEN
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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